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| 10/635,371      | 08/06/2003  | Richard W. Adkisson  | 200208996-1         | 1274             |

22879 7590 05/15/2007  
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| EXAMINER |
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KERVEROS, JAMES C

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| ART UNIT | PAPER NUMBER |
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2117

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| MAIL DATE | DELIVERY MODE |
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05/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/635,371

Applicant(s)

ADKISSON, RICHARD W.

Examiner

JAMES C. KERVEROS

Art Unit

2117

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/6/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This is a non-Final Office Action in response to the present US Application 10/635,371, filed 08/06/2003, which claims benefit of provisional US Application No. 60/469,180, filed 05/09/2003.

Claims 1-26 are presently under examination and still pending in the Application.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification lacks enablement with respect to the claimed limitation "hot signal" recited in the independent claims 1, 9 and 18. Even though, the definition of a "hot signal" is well known in the art, which may imply an active or live signal while the main power is still on, in this case the specification fails to adequately describe the definition of the hot signal as applied to the claimed invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). In this case, the term "hot signal" in the claims is used to mean "a signal during test", while the accepted meaning is "an active or live signal while the main power is still on." The term is indefinite because the specification does not clearly redefine the term. Therefore, for purpose of examination, the "hot signal" is given a broad interpretation to mean a signal generated from a unit under test, when power is still on.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 19 recite the limitation "wherein the N one-hot signals are operable to be encoded on an observability bus coupled to a general purpose performance counter", which renders the claims indefinite, because it is not clear where the encoding operation of the hot signals takes place. In interpreting the claims, the

Examiner assumes that the encoding of the hot signals takes place prior to being loaded on the observability bus.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohsawa (US 5,644,578) issued: July 1, 1997.

Regarding Claims 1, 8, 9, 14, 16, 18, Ohsawa discloses an apparatus and method for a failure memory device for storing failure data in a failure memory in a form of compressed data and can use the data read out from the failure memory as a mask pattern for masking a logical comparison result, Fig. 3, comprising:

An OR logic block comprising a logical comparison circuit 15 having four exclusive-OR circuits and a (mask circuit 16) for selectively masking data output from the logical comparison circuit 15 with the mask pattern stored in the register block (failure memory 17), where mask circuit 16 generates an N-bit output (four bit data), as shown in Fig. 3.

A Multiplexer (MUX) block comprising an OR circuit 18 and a multiplexer 19 for selecting the "Ored" output, which is stored in the register block (failure memory 17).

Regarding Claims 2, 11, 20, Ohsawa discloses the OR logic block comprising a logical comparison circuit 15 having four exclusive-OR circuits and a (mask circuit 16) having four AND gates.

Regarding Claims 3-7, 12,13, 15, 21-25, Ohsawa discloses a Multiplexer (MUX) block comprising an OR circuit 18 and a multiplexer 19 for selecting the "Ored" output, which is stored in the register block (failure memory 17).

Regarding Claims 17, 26, Ohsawa discloses the mask circuit 16, which generates an N-bit output (four bit data), as shown in Fig. 3. Furthermore, Ohsawa discloses a variable bit width memory used as the failure memory 17, which may accommodate any number of bits up to N=80.

Regarding Claims 10,19, Ohsawa discloses, with respect to claimed limitation, "the N one-hot signals are operable to be encoded on an observability bus", and in view of the 112, second rejection, memory under test (MUT) 14, including encoded data written in all the cells of the memory under test based on the address data and the control signal, where the data read out from each cell on an output bus between the MUT and the logical comparison circuit 15 are encoded.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES C. KERVEROS whose telephone number is (571) 272-3824. The examiner can normally be reached on 9:00 AM TO 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques H. Louis-Jacques can be reached on 571) 272-4150. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 8 May 2007

Office Action: Non-Final Rejection

U.S. Patent and Trademark Office

Alexandria, VA 22314

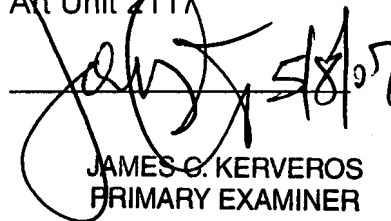
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JAMES C KERVEROS

Primary Examiner

Art Unit 2117

A handwritten signature in black ink, appearing to read 'JCK', is written over a horizontal line. To the right of the signature, the date '5/8/07' is handwritten.

JAMES C. KERVEROS  
PRIMARY EXAMINER